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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/001,512

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Stanley T. Lim

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02/02/2009

SONNENSCHN NATH & ROSENTHAL LLP

P.O. BOX 061080

WACKER DRIVE STATION, SEARS TOWER

CHICAGO, IL 60606-1080

EXAMINER

JANVIER, JEAN D

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

02/02/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/001,512	<b>Applicant(s)</b> LIM ET AL.	
	<b>Examiner</b> JEAN JANVIER	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 15-29, 31-38 and 40-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15-29, 31-38 and 40-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

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### **Response to Applicant's Arguments**

Applicant's arguments with respect to the claimed invention have been considered but are moot in view of the new ground(s) of rejection. Further, the Examiner herein drops the art rejection and intends to allow the claims unless new relevant prior art is found.

### **DETAILED ACTION**

#### **Specification**

#### ***Status of the claims***

1-12, 15-29, 31-38 and 40-43 are currently pending in the Instant Application, while claims 13, 14, 30, 39 and 44-88 are being canceled.

#### **Examiner's Comments**

As far as the claim amendment is concerned, in relation to the estimate, the specification simply discloses in paragraphs [0049] and [0056], but not in paragraphs [0045] and [0050] as featured in the Applicant's current response, :

In an exemplary embodiment, when a consumer sets the bid threshold, the consumer will be able to see an estimate of the number of advertisements that will be sent at that level [0049].

Once the merchant enters a bid level, the system will be able to predict an

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estimate of number of advertisements that will be sent at that level 0056].

### **Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 35 and their dependent claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fail to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor do they physically transform the

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underlying subject matter (such as an article or materials) to a different state or thing. For example, in claim 1, the “setting”, “generating”, “providing the estimate”, “sending” and “providing the user” steps are not performed using a “particular machine” (computer, apparatus, etc.). To be statutory, each claim limitation (each step) should be performed using a “particular machine” (In re Bilski, 88 USPQ2d 1385. (Decided October 30, 2008)). Claims 2 and 35 suffer from similar deficiencies and are rejected under a similar rationale.

Further, the Examiner notes that Applicant may show that a process claim satisfies §101 either by showing that Applicant's claim is tied to a particular machine, or by showing that Applicant's claim transforms an article (See Benson, 409 U.S. at 70). Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility (See Benson, 409 U.S. at 71-72). Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity (See Flook, 437 U.S. at 590).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 5,974,398 to Hanson discloses an advertising bidding system that displays on a user's screen a plurality of bid tags, from a plurality of advertisers, along with respective bid prices, wherein the user himself selects a bid tag with its respective price to indicate that he wants to read the advertisement associated with the selected bid tag for the displayed price tag (broadly

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interpreted, the user sets the price he wants to receive for reading an associated ad by selecting a price tag next to a related bid tag). See figs. 4-5.

USP 6,195,698B1 to Lillibridge discloses a method for selectively accepting access requests from a client computer connected to a server computer by a network. The server computer receives an access request from the client computer. In response, the server computer generates a predetermined number of random characters. The random characters are used to form a string in the server computer. The string is randomly modified **either visually or audibly to form a riddle**. The original string becomes the correct answer to the riddle. The server computer renders the riddle on an output device of the client computer. In response, the client computer sends an answer to the server. Hopefully, the answer is a user's guess for the correct answer. The server determines if the guess is the correct answer, and if so, the access request is accepted. If the correct answer is not received within a predetermined amount of time, the connection between the client and server computer is terminated by the server on the assumption that an automated agent is operating in the client on behalf of the user (See abstract).

USP 6,529,878B2 to De Rafael discloses a system and method for compensating users for responding to advertisements in an interactive manner that poses questions for users and dynamically generates further questions in response to users' answers to previous questions. A user sets up an account on a remote computer that is then credited each time a user has completed the series of questions and answers relating to an advertisement. In setting up the account, the remote computer obtains demographic information from the user, such as the user's name, age, gender, place of residence and occupation. The remote computer can generate the questions not only in response to answers to previous questions but also in response to the

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demographic information. The remote computer provides the advertisers with the users' answers or with statistical information computed in response to the answers and the user demographics.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. James Myhre, can be reached at (571) 272- 6722.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

01/26/09

/J. J./

/Jean Janvier/

Primary Examiner, Art Unit 3688